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**REMARKS**

Applicant respectfully traverses Examiner's conclusions in relation to the claims of the present application. MPEP 706 makes the point that "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." In this case, all the features are simply referred as being shown in "Figures 2, 4 and 6", which Applicant submits is wholly inadequate given the complexity of the citation and the large number of features claimed in the independent claims of the present application. Contrary to Examiner's conclusion, a large number of the features in the claims are not disclosed or suggested in any way by the citation. Should Examiner wish to maintain the present claim rejections, Applicant requests that the correspondence between claimed features and equivalent features alleged to be shown by the citations be explicitly pointed out by Examiner.

Turning to the specific rejection, to begin with, Merchant fails entirely to disclose a number of critical features defined in the claims presently on file. By way of general comparison, Merchant is concerned with providing a tablet-based display screen and associated stylus to enable a user to, amongst other things, send a fax to another user. The system is illustrated schematically in Figure 3, and in perspective view in Figure 2.

In contrast, the present invention as claimed is concerned with a *printed* form that includes information and coded data. By using a sensing device to interact with the coded data, a user can compose and send a fax via the sensing device.

To simplify the identification of the omissions of Merchant compared to the present claimed invention, the claims will be considered on a feature by feature basis (text of the claims is in *italics*).

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**Claim 25:**

*A method of enabling composition of a facsimile by a user and delivery thereof,*

- Applicant confirms that Merchant discloses this feature.

*utilizing a form printed onto at least one surface,*

- Merchant does not disclose or suggest this feature. Merchant is wholly concerned with the provision of an active tablet and stylus combination. The word "printed" is never used in the context of providing a form for a user to interact with.
- Applicant reminds Examiner that, in accordance with MPEP 2111.01, the words of a claim must be given their "plain meaning" unless they are defined in the specification. Applicant also points out that "plain meaning" refers to the meaning of the term as would be understood by one skilled in the relevant art. In the present case, the plain meaning of the word "printed" as used in the claim is that some form of printing process must have been used to generate the form. It is incorrect to infer that one skilled in the art, when talking of a "printed" form, would intend that an active display screen such as that disclosed in Merchant should be included. Should Examiner wish to maintain this aspect of the rejection, Applicant requests that support for expanding the plain meaning of the word "printed" to include an active tablet and stylus arrangement be provided. When doing so, Examiner should bear in mind that the entire present specification is concerned with printing technology that uses a printer to deposit ink on print media such as paper, and that there is no disclosure suggesting in any way that the invention is intended to have anything to do with active tablet and stylus systems.

*the form including information relating to the user*

- Even in the event one were to stretch the definition of a printed form to include an active tablet and stylus combination, the feature of the form including information relating to the user is not disclosed in Merchant. Figure 6 of Merchant shows the screen that is displayed to a user for filling in. Clearly any information about the user must be input by users themselves (eg, the "From" field that is blank until filled in by user with the stylus). There is no disclosure of providing a form that already includes this information.

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*and at least one area for the user to enter a message,*

- Merchant discloses an area for entering a message (see Figure 6), although it is not applicant's contention that this feature, of itself, provides patentable subject matter in the present claims.

*the at least one surface having coded data indicative of an identity of the form and of the at least one area,*

- Merchant does not disclose or suggest this feature. Examiner suggests that the feature exists, but refers only to Figures 2, 4 and 6 in support of this. Merchant discloses an active tablet and stylus combination that in no way incorporates "coded data". Applicant again reminds Examiner of the need to interpret claim language on the basis of its plain meaning as would be understood by one skilled in the art. In the present case, there is nothing disclosed in Merchant that one skilled would interpret as being "coded data" as defined in claim 25.
- Moreover, any data that is displayed by the tablet in Merchant is not "indicative of an identity of the form", nor is it "indicative" of the area defined earlier in the claim.

*the method including the steps of:*

*providing the form to the user;*

- A form is provided to a user in Merchant, although the form so provided does not correspond with the form defined in the present claim.

*receiving, in a computer system, interaction data from a sensing device used to compose the message,*

- In Merchant, there is data generated as a result of interaction between the stylus and tablet setup used for accepting written input from a user.

*the interaction data being indicative of an identity of the form*

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- There is no disclosure in Merchant of interaction data being indicative of an identity of the form. Applicant requests that Examiner point out where in Merchant this feature is disclosed or even suggested.

*and a position of the sensing device relative to the area,*

- It is implicit in Merchant that positional data is generated relating to a position of the stylus relative to the tablet surface, in order to allow input of handwritten data.

*the sensing device, when placed operatively relative to the area in order to compose the message,*

- Applicant requests that Examiner specify which particular element in Merchant is considered the "sensing device". If it is the tablet, then Merchant fails entirely to disclose that the sensing device is placed operatively relative to the area, since the area is in fact displayed on a screen of the sensing device.
- If the sensing device is considered the stylus (as seems presently to be implied by Examiner), then Applicant points out that the stylus is, in fact, passive, and therefore unable to be a "sensing device" on the basis of the plain meaning of those words to one skilled in the art. As described at column 3, lines 7-14, the display screen of the tablet (or SCR) "is responsive to touch by the pen stylus input device". It must therefore be concluded that the only sensing taking place is being performed by the tablet, rather than the stylus. In the absence of any sensing function, the stylus cannot logically be considered a "sensing device".
- If the tablet and stylus are considered together to form a "sensing device", then that device cannot logically be "placed operatively relative to the area in order to compose the message", since the area is in fact displayed on the tablet. This is akin to suggesting that a device can be positioned relative to itself, which is semantically impossible.

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*generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position;*

- This feature further distinguishes the present invention from Merchant. The interaction data in Merchant is not generated by "sensing at least some of the coded data in the vicinity of the position". Rather, any interaction data is generated by the tablet sensing a position of the stylus on its surface. The feature of a tablet sensing movement of a stylus along its surface is nothing new, and is not, in relation to prior art arrangements, something that the present claims are intended to encompass. Applicant requests that Examiner identify precisely the features in Merchant that are alleged to correspond with the coded data and the sensing of such coded data based on a position of a sensing device.

*capturing electronically, in the computer system and from the interaction data, at least the message,*

- In Merchant, there is arguably capture of a message in a computer system, although the interaction is generated differently compared to the arrangement of Merchant.

*and*

*transmitting the message to a designated recipient address for facsimile delivery.*

- There is disclosed in Merchant the transmission of a message to a designated recipient address.

For all these reasons, Applicant submits that Merchant entirely fails to disclose or suggest a large number of critical features of the present invention as defined in claim 26, and that the rejection should therefore be withdrawn.

#### **Claim 26**

*The method of claim 1 which includes causing the form to be printed in response to receiving, in the computer system, a request for the form.*

- Examiner suggests that this feature is disclosed in Tanaka, and that it is obvious to combine Tanaka with Merchant to anticipate the invention as defined in this claim.

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Applicant disagrees.

- Tanaka is utterly irrelevant to an assessment of the patentability of the present claims, and Applicant again requests that Examiner provide the specific location of the features that Tanaka is said to disclose in relation to this and other claims against which it is cited.
- Regarding claim 26, Tanaka is concerned with an information processing system that is equipped with a copying apparatus. The apparatus described in Tanaka provides the ability to merge data from a computer into a form that is being copied. This is done by using a master form with coded data to determine locations for merging of data. The data is then fetched from the computer system and input at the correct position on sheets being reproduced.
- The disclosure of Tanaka cannot be used to rectify the omissions of Merchant. Applicant reminds Examiner that under MPEP 706.02(j), to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Applicant submits Examiner has provided no support for any of these three requirements. Dealing with them individually:
  - (1) Tanaka is from an entirely different field (data merging in a form copying system) from Merchant (tablet and stylus-based fax entry and transmission system). There is no teaching in either document that would suggest the desirability of incorporating the features of either of these documents into the other. The fact that references can be combined (and applicant rejects this is the case) is not sufficient by itself to provide *prima facie* obviousness (MPEP 2143).
  - (2) There is no reasonable expectation of success, since there is no obvious way in which the features of the two documents could be combined. Merchant

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discloses accepting handwritten input via a tablet and stylus arrangement and transmitting a fax of the input to a recipient. Tanaka discloses scanning a physical document to determine positions for data merging on a form to be copied, then merging data from a database into the form fields during printing. Examiner has made no case as to why someone skilled in the art would expect to successfully combine these two completely different technologies to result in the present invention as defined in any of the claims.

- (3) The combination of Merchant and Tanaka does not result in the present invention as claimed in any of the claims. Examiner has provided no indication of how these features could possibly be combined by one skilled in the art to result in the present invention as claimed in any of the claims. The "stylus" referred to in Tanaka (and by Examiner in relation to Tanaka) at column 5, lines 8 to 14, is described as being part of each of a number of needle electrodes that provide an electrostatic charge to a piece of paper during the printing process. There is no disclosure of using a stylus to input data, as happens in Merchant. Applicant is therefore at a loss to understand how Examiner has concluded that the input stylus from Merchant can be combined with the electrostatic stylus of Tanaka in any way, let alone in a way that is even remotely related to the present invention as claimed. Applicant requests that Examiner either explain how such an arrangement has any relationship to the user input stylus of Merchant and how such a combination relates to the present claims, or withdraw the objection based on this combination of documents.

**Claim 27**

*The method of claim 1 or claim 2 which includes causing the form and the coded data to be printed onto the at least one surface substantially simultaneously.*

- As explained above, there is no coded data disclosed in Merchant (or Tanaka for that matter). Also, the step defined in this claim is the simultaneous printing of the form and coded data onto a surface. On the basis of the ordinary meaning of "printing", nothing is being printed onto a surface in Merchant, other than perhaps the fax at the received end. This claim is concerned with providing coded data and a form onto a

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surface using a printing process. Nothing in Merchant or Tanaka suggests any such combination, so Applicant submits the objection should be withdrawn.

**Claim 28**

*A method as claimed in any one of the preceding claims, wherein the message is delivered with a reply number for sending a return message, the reply number being valid for a predetermined time only.*

- Examiner appears not to have considered this claim in its entirety. The requirement is not merely that a reply number be provided, but that the number be valid only for a predetermined time. Applicant has reviewed Merchant carefully and can see no evidence of such a feature. If Examiner is unable to specifically point out this feature in Merchant, it is respectfully submitted that the objection to this claim should be withdrawn.

**Claim 29**

*A method as claimed in any one of the preceding claims, wherein a sender of the message indicates on the form, using the sensing device, whether a reply number is to be transmitted with the message.*

- Corresponding comments apply to claim 29 as to claim 28. Where in Merchant is there any disclosure of a user being able or required to indicate whether a reply number is to be transmitted with the message?

**Claim 32**

*A method as claimed in any one of the preceding claims, including receiving, in the computer system, movement data regarding movement of the sensing device relative to the form.*

- As explained above, it is not logically possible for any sensing device shown in Merchant to move relative to the form, since the form is displayed on the tablet.

**Claim 33**

*A method as claimed in claim 8, wherein the sensing device generates the movement data using at least some of the coded data.*



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- This is not disclosed in Merchant, for the reasons given in relation to claim 32.

**Claim 34**

*A method as claimed in any one of the preceding claims wherein the coded data is substantially invisible to the average unaided human eye.*

- Merchant does not disclose the use of coded data as defined in the present claims, so it makes no sense to suggest it would be obvious to modify it with reference to any system that does use such coded data. Tanaka is not a suitable reference in any event, for the reasons given above.

**Claim 35**

*A method as claimed in any one of the preceding claims, which includes retaining a retrievable record of each form printed, the record being retrievable using at least some of the coded data on the surface on which the form is printed.*

- Merchant does appear to disclose the step of saving a copy of sent faxes. However, there is utterly no suggestion that the saved copies are retrievable using coded data on the surface of a form, since there is no disclosure of coded data (as defined in the present claims) anywhere in Merchant. Again, if Examiner disagrees with this interpretation, Applicant requests that the specific features to which Examiner eludes be identified explicitly in any further Office Action.

**Claims 36 to 47**

These claims correspond in scope with claims 25 to 35, and corresponding comments apply.

**OTHER CLAIMS**

A number of the claims have not explicitly been discussed, but are believe to be patentable both in their own right and due to their dependence on allowable base claims.

**OTHER CITATIONS**

Examiner contends that Boyer is pertinent to the present invention. Applicant disagrees. Boyer is concerned with using an active tablet and stylus arrangement that "emulates the ease of entering handwritten information on a printed form" (column 3, lines 13-14). In

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doing so, Boyer teaches directly away from the use of a printed form. As described above, the present invention is solely concerned with sending a fax by using coded data on a printed form. Boyer therefore teaches squarely away from the present invention as claimed, and cannot be considered relevant. There is also no disclosure of sending a fax to a recipient based on input data.

Examiner contends that Johnson is pertinent to the present invention. Applicant disagrees. Johnson is concerned with providing preprinted forms that have predetermined data entry areas. Users can enter information into the data entry areas. A scanner is then used to scan the information into a computer. There is no disclosure of determining a position of a sensing device as a way of generating interaction data, as defined in the present claims. There is also no disclosure of sending a fax to a recipient based on input data.

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**CONCLUSION**

If Examiner still believes that the claimed features are disclosed in the citations, and that, where appropriate, it would be obvious to combine them to anticipate the present invention as claimed, Applicant requests that each and every one of the specific features in every claim be identified by reference to a specific corresponding feature in the citations. Examiner is reminded that citations can only be anticipatory if they disclose each and every one of the limitations of the claims. The present Office Action fails entirely to do this, and as such does not present even a prima facie case for the relevance of the prior art to the present invention as claimed.

In event Examiner is not persuaded by these arguments, Applicant submits that the present Office Action was not detailed enough to allow Applicant to respond completely to Examiner's opinion. Applicant therefore submits that in the unlikely event that Examiner wishes to maintain the rejection of the present claims based on the present citations, it would be highly inappropriate for the next Office Action to be made Final.

Very respectfully,

Applicants/Inventors:



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